



DFW

PATENT
Customer No. 22,852
Attorney Docket No. 08981.0003-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Jia-Ning XIANG et al.)	Group Art Unit: 1625
)	
Application No.: 10/728,942)	Examiner: Bernard I. DENTZ
)	
Filed: December 8, 2003)	Confirmation No.: 9013
)	
For: CARBIDOPA PRODRUGS AND)	
DERIVATIVES, AND)	
COMPOSITIONS AND USES)	
THEREOF)	

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Applicants now respond to the Office Action mailed August 19, 2005.

The Examiner required restriction to one of the following twelve groups of claims:

Group I: claims 1-4, 6-47, 81-83, and 118, allegedly drawn to compounds where R1 is H and X is OR1, classified in class 562, subclass 439.

Group II: claims 1-3, 5-47, and 118, allegedly drawn to compounds where X is OR10 and R1 is formula IX, classified in class 560, subclass 24.

Group III: claims 1, 48, 49, 51, 54-69, 74-80, 84-92, 96-101, and 113-118, allegedly drawn to compounds where X is of the formula II and R1 is H, classified in class 562, subclass 34.

Group IV: claims 1, 48, 49, 52, 54-69, 74-80, 96-101, and 113-118, allegedly drawn to compounds where X is formula II and R1 is formula IX, classified in class 560, subclass 24.

Group V: claims 1, 48-52, 54-73, and 93-118, allegedly drawn to compounds where X is formula III and R1 is H, classified in class 560, subclass 34.

Group VI: claims 1, 48-51, 53-73, and 93-118, allegedly drawn to compounds where X is formula III and R1 is IX, classified in class 560, subclass 24.

Groups VII-XII: claims 119-126, allegedly drawn to pharmaceutical compositions containing a compound of the respective above group and at least one additional active agent.

The Examiner also noted that after a compound has been found allowable, a single method of use will be examined. Action at Page 2. The Examiner further required election of a single supported species, in case no generic claim is found allowable. Action at Page 3.

In two telephonic interviews with the undersigned on August 31, 2005, and September 9, 2005, the Examiner agreed with the undersigned that Group III should contain claim 52 instead of claim 51 and that Group IV should contain claim 53 instead of claim 52. The Examiner also stated that claim 126 is a method of use claim and not a claim drawn to a pharmaceutical composition and therefore does not belong in Groups VII-XII. In addition, the Examiner agreed with the undersigned that claim 136 is not a method of use claim, but stated that it could not be added to any of the groups defined above. The Examiner stated that claim 136 should be put in its own group. Applicants thank the Examiner for these clarifications.

Based on these interviews, the groups should be as follows:

Group I: claims 1-4, 6-47, 81-83, and 118, allegedly drawn to compounds where R1 is H and X is OR1, classified in class 562, subclass 439.

Group II: claims 1-3, 5-47, and 118, allegedly drawn to compounds where X is OR10 and R1 is formula IX, classified in class 560, subclass 24.

Group III: claims 1, 48, 49, 52, 54-69, 74-80, 84-92, 96-101, and 113-118, allegedly drawn to compounds where X is of the formula II and R1 is H, classified in class 562, subclass 34.

Group IV: claims 1, 48, 49, 53, 54-69, 74-80, 96-101, and 113-118, allegedly drawn to compounds where X is formula II and R1 is formula IX, classified in class 560, subclass 24.

Group V: claims 1, 48-52, 54-73, and 93-118, allegedly drawn to compounds where X is formula III and R1 is H, classified in class 560, subclass 34.

Group VI: claims 1, 48-51, 53-73, and 93-118, allegedly drawn to compounds where X is formula III and R1 is IX, classified in class 560, subclass 24.

Groups VII-XIII: claims 119-125, allegedly drawn to pharmaceutical compositions containing a compound of the respective above group and at least one additional active agent.

Group XIV: claim 136.

Applicants elect the following without traverse:

- Group III, containing claims 1, 48, 49, 52, 54-69, 74-80, 84-92, 96-101, and 113-118; and
- compound 183 as described in Example 47, paragraphs [00388] and [00389] on page 83 of the specification.

Applicants reserve the right to pursue the subject matter of the non-elected groups and species in a one or more divisional applications.

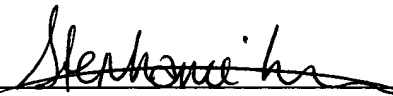
If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 19, 2005

By: _____


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